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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,194	11/13/2000	Casey William Norman	1391-CIP-00	6427

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IP DEPARTMENT OF PIPER RUDNICK LLP
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EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 06/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,194

Applicant(s)

NORMAN ET AL.

Examiner

Jamila Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 3/27/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Note: The indication of allowable subject matter in the office action mailed 9/25/02 has been withdrawn in view of the following rejection.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,3-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-23,25-51 of copending Application No. 09/844322. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are similar in scope and subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda. Yasuda discloses a seamless doll's skin or garment (fig 1) comprising a seamless, molded elastomeric material (column 3 lines 18-54 of the specification) adapted to be repeatedly dressed, fitted over and removed from a doll to transform the doll into a different character or object (inherently capable of this function); wherein the elastomeric material is a synthetic polymer, which is a copolymer consisting ethylene-vinyl acetate copolymer (column 3 lines 24-25).
5. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by '774 to Fogarty. Fogarty discloses a seamless doll's skin (70,80) comprising seamless, molded elastomeric material (column 4 lines 47-49 and 66-68, in that plastic materials encompass elastomeric properties, see fig 8) adapted to be repeatedly dressed, fitted over and removed from a doll to transform the doll into a different character or object (figs 11-13).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-11,13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda. Yasuda discloses all of the elements of the claims except for the modulus of elasticity, as recited in claims 6,13,14 and the adaptability of the garment to be used with dolls of a specific height range, as recited in claims 7-8,10 and form as recited in claim 9. In that the material of Yasuda is elastomeric, it inherently has a modulus of elasticity. It would have been obvious to one having ordinary skill in the art to construct the material of Yasuda to have the claimed modulus of elasticity for the purpose of providing better elastic properties or flexibility of the material.

Regarding the limitation that the garment or skin is adapted to be used with a doll having a specific height range. It is old and well known to make dolls of various heights and sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material of Yasuda usable with dolls of varying height ranges. Regarding the skin having a specific form as recited in claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda to form an animal since the material is disclosed to be used as fur of stuffed animal toys (column 19 lines 62).

Regarding the limitations of claims 13 where the applicant is claiming both a doll's skin and garment. It appears from the specification (page 4 line 20) that "the garment is a skin". Therefore the examiner maintains that Yasuda meets the requirements of the claim as stated above.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda in view of '774 to Fogarty. Yasuda discloses all of the elements of the claims as applied to claim 11 above. Yasuda does not, however, disclose the garment having at least one integrally molded detail. Fogarty teaches molded doll garments having integrally molded details (fig 4, 9). It would have been obvious to use the teaching of an integrally molded feature of Fogarty with the garments (doll clothes) of Yasuda for the purpose of making the garment more realistic.

8. Claims 3-5, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda. Fogarty discloses all of the elements of the claims including molded elastomeric material used as a doll's skin, as applied to claim 1 above and the skin having the form of a cartoon character (cowgirl, princess). Fogarty does not however disclose the specifics of the material as recited in claims 3-5. Yasuda provides a teaching for a synthetic polymer which is a copolymer consisting of ethylene-vinyl acetate copolymer (column 3 lines 24-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda with the skin of Fogarty for the purpose of providing more flexibility.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda. Fogarty discloses a play set including a doll donned and fitted with a flexible plastic garment which removably encloses around at least a part of the doll and is adapted to be removed, dressed and refitted again to the doll (fig 9-13). Fogarty does not however specifically provide a teaching of a synthetic polymer

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for the garment nor the height range for the doll. Yasuda discloses a material used for doll clothes (garments) including a synthetic polymer (column 3 lines 18-25 of the specification). It would have been obvious to use the material of Yasuda with the garments of Fogarty for the purpose of providing more flexibility. Regarding the height range of the dolls. It is old and well known to make dolls of different heights and sizes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the height of the doll as a matter of design choice and for the purpose of providing a more reasonably sized doll for different users.

10. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda and further in view of Gross. Fogarty and Yasuda disclose all of the elements of the claims as recited above. However a doll articulated at a joint, as recited in claim 16 is not disclosed. Gross teaches a doll articulated at the elbow and knee (see fig 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the joints of Gross with the doll and garments of Fogarty and Yasuda for the purpose of providing a more realistic play set for the user.

Response to Arguments

11. Applicant's arguments with respect to claims 1,3-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 703-305-3312. The examiner can normally be reached on Monday-Friday 6:30-3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

June 13, 2003



DERRIS H. BANKS
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